



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Venegas, Jr.

Serial No.: 09/779,782

Group No.: 3635

Filed: Feb. 8, 2001

Examiner: S. Varner

For: BARRIER COVER

**APPELLANT'S CORRECTED BRIEF**

Mail Stop Appeal Brief  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice of Non-Compliant Appeal Brief dated December 16, 2004, herein is Appellant's Corrected Appeal Brief.

**I. Real Party in Interest**

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

**II. Related Appeals and Interferences**

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims**

The present application was filed with 7 claims. Claim 1 was canceled, and claims 8-9 were added in November 2002. Claims 10-21 were added in October 2003. Claims 10 and 13 have been canceled, leaving pending claims 2-9, 11-12 and 14-21. Claims 16-21 are deemed allowable. Claims 2-9, 11, 12, 14, and 15 are under appeal. Claims 8 and 11 are independent.

**IV. Status of Amendments Filed Subsequent Final Rejection**

No after-final amendments have been filed.

**V. Summary of Claimed Subject Matter**

Independent claim 8 provides a cover for a tubular metal guard rail of the type having two below-ground ends and a substantially semi-circular above-ground midsection connecting the two ends, the cover comprising: spaced-apart opaque front and back panels, each having a corresponding bottom edge, opposing side edges and a top edge; a side panel connecting the sides and tops of the front and back panels, leaving a slot open at the bottom to receive the metal guard rail in slip-fit engagement such that the bottom edges are adjacent the ground surface; and wherein the front and back panels smoothly transition through semi-circular side edges corresponding to the tubular metal guard rail (Specification, page 3, lines 5-11; page 5, line 11 to page 6, line 8; Figures 1, 3).

Independent claim 11 provides a cover for a tubular metal guard rail of the type having two below-ground ends and a substantially semi-circular above-ground midsection connecting the two ends, the cover comprising: spaced-apart front and back panels, each having opposing bottom edges, side edges, and semi-circular top edges corresponding to the semi-circular mid-section of the guard rail; a side panel connecting the sides and tops of the front and back panels, leaving a slot open at the bottom to receive the metal guard rail in slip-fit engagement such that the bottom edges are adjacent the ground surface; and wherein at least one of the front and back panels includes an advertising display [Specification, page 3, line 18 to page 4, line 7; page 5, lines 11-12; Figures 1-2 (item 10)].

**VI. Grounds of Objection/Rejection To Be Reviewed On Appeal**

A. Claims 2-4 and 8-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,678,707 to Finkelstein.

B. Claims 11, 12 and 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,874,103 to Muta.

C. Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,678,707 to Finkelstein in view of U.S. Patent No. 6,263,601 to Emert.

D. Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,678,707 to Finkelstein in view of U.S. Patent No. 5,438,950 to Rodrigues.

## VII. Argument

### Background

This patent application was filed in February, 2001, over three and one-half years ago. The examination of the application has been poorly reasoned and haphazard. Frustrated, Appellant a first appeal brief in May, 2003. Prosecution was reopened with rejections over prior art that was no more relevant than previously cited references.

In November, 2003, Appellant received a final Office Action, wherein claims 6, 10, 13 and 14 were objected to, and claims 16-21 were allowed. Reasons were allowance were given. To expedite prosecution, Appellant took the objected-to claims and redrafted them in independent form, keeping allowable 16-21 claims, fully anticipating a Notice of Allowance. Instead, in February 2004, Appellant received an Advisory Action, entering the amendment, but stating that claims 2-9, 11, 12, 14 and 15 continued to be rejected. No reasons were given.

Appellant's undersigned representative attempted several telephone calls to the Examiner to clarify the situation, and upon finally making contact, the Examiner stated that the case may or may not be allowable, but again, did not give reasons, stating that he would have to talk to his supervisor. The undersigned tried to explain that Appellant simply took objected-to and allowed claims and formatted them for an allowance, but the Examiner did not seem to understand. Accordingly, to keep the case open, Appellant filed yet another Notice of Appeal.

Several more attempts were made to call the Examiner and his Supervisor, but without satisfaction. Now this appeal brief is being filed on the maximum extension date, causing all involved to expend unnecessary resources and money for no apparent reason.

### A. Rejection of Claims 2-4 and 8-9 under 35 U.S.C. §102(b)

In the final Office Action, the Examiner stated that claim 10 is allowable "for the front and back panels smoothly transitioned [sic] through semi-circular side edges corresponding to the tubular metal guard rail." In response, Appellant took the limitation of claim 10 and added it to claim 8, canceled

claim 10 and changing the dependency of claims 2-7. Based upon the record, this group of claims should be allowable.

B. Rejection of Claims 11, 12 and 15 under 35 U.S.C. §102(b)

In the final Office Action, the Examiner stated that claim 13 "is allowable for the front and back panels including an advertising display." In response, Appellant took this limitation and put it into claim 11, canceling claims 13, but keeping the dependency of claims 12, 14 and 15 from claim 11. Based upon the record, this group of claims should continue to be allowable.

C. Rejection of Claim 5 under 35 U.S.C. §103(a)

Claim 5 is dependent on claim 2, which, in turn, is dependent on allowable 8. Therefore, this claim should be allowable as well.

D. Rejection of Claim 7 under 35 U.S.C. §103(a)

Claim 7 is dependent on claim 2, which, in turn, is dependent on allowable 8. Therefore, this claim should be allowable as well.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: \_\_\_\_\_

John G. Posa  
Reg. No. 34,424  
Gifford, Krass, Groh, Sprinkle,  
Anderson & Citkowski, P.C.  
PO Box 7021  
Troy, MI 48007-7021  
(734) 913-9300

Date: Jan. 17, 2005

**APPENDIX A**  
**CLAIMS ON APPEAL**

2. The protective cover of claim 8 wherein at least one of the front and back panels includes an advertising display.
3. The protective cover of claim 8 further including a fastener for securing the cover to the guard rail.
4. The barrier cover of claim 2 wherein the advertising display is a message of stenciled letters.
5. The barrier cover of claim 2 wherein the advertising display is an electrical/electronic circuit comprising one or more lighting elements configured to display a message or image.
6. The barrier cover of claim 2 wherein the advertising display is one or more magnetically mounted objects of a ferro-magnetic material disposed on metallic surface.
7. The barrier cover of claim 2 wherein the advertising display is hook-and-loop materials or a chalkboard surface.
8. A cover for a tubular metal guard rail of the type having two below-ground ends and a substantially semi-circular above-ground midsection connecting the two ends, the cover comprising:  
spaced-apart opaque front and back panels, each having a corresponding bottom edge, opposing side edges and a top edge;  
a side panel connecting the sides and tops of the front and back panels, leaving a slot open at the bottom to receive the metal guard rail in slip-fit engagement such that the bottom edges are adjacent the ground surface; and  
wherein the front and back panels smoothly transition through semi-circular side edges

corresponding to the tubular metal guard rail.

9. The cover of claim 8, wherein the side edges smoothly transition in the top edge to create arc-shaped front and back panels that correspond to the semi-circular mid-section of the guard rail.

11. A cover for a tubular metal guard rail of the type having two below-ground ends and a substantially semi-circular above-ground midsection connecting the two ends, the cover comprising:  
spaced-apart front and back panels, each having opposing bottom edges, side edges, and semi-circular top edges corresponding to the semi-circular mid-section of the guard rail;

a side panel connecting the sides and tops of the front and back panels, leaving a slot open at the bottom to receive the metal guard rail in slip-fit engagement such that the bottom edges are adjacent the ground surface; and

wherein at least one of the front and back panels includes an advertising display.

12. The protective cover of claim 11, further including a fastener for securing the cover to the guard rail.

14. The protective cover of claim 11, wherein at least one of the front and back panels is opaque.

15. The protective cover of claim 11, wherein the front and back panels smoothly transition through semi-circular side edges corresponding to the tubular metal guard rail.

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**APPENDIX B**

**EVIDENCE**

None.

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**APPENDIX C**  
**RELATED PROCEEDINGS**

None.